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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,941	01/03/2002	Carolyn Jean Cupp	112701-330	7917
29157	7590	04/02/2004		
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			EXAMINER HENDRICKS, KEITH D	
			ART UNIT	PAPER NUMBER
			1761	

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/037,941

**Applicant(s)**

CUPP ET AL.

**Examiner**

Keith Hendricks

**Art Unit**

1761



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 1761

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-21 and 31 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 remains indefinite for the recitation of the phrase "comprising the steps of... chewing on dried pet food...". Applicant has amended the claim by adding the phrase "feeding a dry pet food to a pet". However, this does not address or alleviate the issue. The only two recited active steps within the claim involve one skilled in the art (a) "feeding a dry pet food to a pet", and (b) "chewing on dried pet food...". The claim does not address the pet actually chewing on the pet food. While it is not believed that it is applicant's intention to have one skilled in the art actually chew the pet food, nonetheless, this is what is recited, and thus the rejection is maintained for the reasons of record. Again, the claim does not clearly state that the pet consumes or chews on the food, and thus it must be assumed that the reader, i.e. one skilled in the art, is to chew on the food.

In claim 21, it is noted that the phrase "one size kibble being larger than the other size kibble" is redundant, in view of the phrase "at least two different sized kibbles", recited previously in the claim. Furthermore, the phrase "one size kibble being larger than the other size kibble" necessarily limits the claim to two differently-sized kibbles, whereas this conflicts with the phrase "at least two different sized kibbles." In the response of December 30, 2003, applicant does not specifically address this rejection, and has not amended the claim in response to this rejection. Thus applicant's statement that "with respect to the issues regarding claims 20, 21, 29 and 30, these claims have been amended in response to same," is not deemed persuasive.

Claim 31 is indefinite for the recitation of the phrase "large number". The term "large" is a relative term which renders the claim indefinite. In applicant's response of December 30, 2003, applicant states that "the specification provides sufficient support for this term. For example, the specification provides that the interior of the dried pet food product can have a large number of microscopic air pockets." This has been considered but not deemed persuasive. It is unclear as to how this addresses the issue, and how this passage provides a clear definition of the claim language. Simply because the specification provides support for the language, does not mean that the language contained in the

Art Unit: 1761

specification is any more clearly defined than that of the claims. Again, the term is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7-12, 18, 20, 25, 27, 28, and 30-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Collings et al. (EP 0 645 095). The reference and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed December 30, 2003, have been fully considered but they are not persuasive. At page 8 of the response, applicant states that

For example, Collings is deficient with respect to a pet food product that has pet food product characteristics as claimed, such as a density that ranges from about 16.8 lbs/ft<sup>3</sup> to about 20 lbs/ft<sup>3</sup>. Clearly, Collings provides a product density that is outside of the claimed density range based on, for example, what Collings discloses at page 6 in lines 10 and 11.

This is not deemed persuasive for the reasons of record. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Further, they do not show how the amendments avoid such references or objections. For example, applicant's statement that "clearly, Collings provides a product density that is outside of the claimed density range" does not find support within the referenced passages. Applicant has provided no logic or data to support their conclusionary statement, whereas the previous Office action has both clearly addressed this issue and provided logical support for the conclusions therein.

Also at page 8 of the response, applicant states that

Further, the claimed density features are not an inherent property of the dog food product as disclosed or suggested in Collings contrary to what the Patent Office seems to suggest. Indeed, the primary focus of Collings relates to an extruded dog food product that has improved resistance to breakage on shipping and handling and not improved dental cleaning properties, let alone due, at least in part, to the product density.

Art Unit: 1761

This is not deemed persuasive for the reasons of record.

In response to applicant's argument, the fact that applicant may have recognized another advantage which would flow naturally from following the teachings of the prior art cannot be the basis for patentability when the differences would otherwise be obvious, or in the instant case, inherent. Applicant appears to be stating that, although the product of Collings et al. provides improved resistance to breakage on shipping and handling, this would somehow not translate to improved resistance to breaking upon chewing by a pet. Applicant has utilized the phrase "improved dental cleaning properties" in their arguments, which is not found in the claims. In fact, however, applicant's own specification, at the top of page 9, states that "being of a low density, the foam [i.e. claimed product] absorbs tooth pressure without splintering and/or crumbling during the chewing process." Thus, regardless of the source of the external pressure applied to the product, be it a shipping package material or a pet's teeth, the same properties (a) are present and inherent, and (b) would be the result of the same components and overall structure within both the claimed and referenced products.

Thus and again, although the reference does not specifically disclose every possible quantification or characteristic of its product, including density data, the density of the product would have been within the instantly-claimed range of "about 16.8 lbs/ft<sup>3</sup> to about 20 lbs/ft<sup>3</sup>", absent any clear and convincing evidence and/or arguments to the contrary. The reference discloses the same starting materials and methods as instantly (both broadly and more specifically) claimed, and thus one of ordinary skill in the art would recognize that the product density, among many other characteristics of the referenced product, would have been an inherent result of the product disclosed therein. Similarly, regarding instant claims 28 and 31-33, the resultant texture of the extruded product would also have been an inherent result of the disclosed product, based upon the same starting materials and methods of production. Furthermore, at page 5 the reference states that the "plasticized food" component "swells upon exiting the die due to flashing of moisture to steam producing an expanded structure" (lines 8-9). This process is similar to that found in the production of cheese puffs, which also expand upon exiting the heated extruder through a constrictive exit passageway, and also contain pockets of air and circular pores as a result of this process. The Patent Office does not possess the facilities to make and test the referenced product, and as a reasonable reading of the teachings of the reference has been applied and does anticipate the instant claims, the burden thus shifts to applicant to demonstrate otherwise.

Art Unit: 1761

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 13-17, 19, 21-24, 26 and 29 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Collings et al., in view of Hand et al. (US PAT 5,431,927). The references and rejection are incorporated as cited in a previous Office action.

Applicant's arguments filed December 30, 2003, have been fully considered but they are not persuasive. At page 9 of the response, applicant states that "even if combinable, Applicants do not believe that the Patent Office can rely solely on Hand to remedy the deficiencies of Collings. Therefore, Applicants believe that the claimed invention is clearly distinguishable over the cited art."

This is not deemed persuasive for the reasons of record. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Simply stating that the applicant does not "believe that the Patent Office can rely solely on Hand to remedy the deficiencies of Collings", is insufficient to rebut the rejection, and the issues and facts addressed therein.

Art Unit: 1761

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

i) Claims 1-33 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of copending Application No. 09/154,646.

ii) Claims 1-33 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/052,949.

iii) Claims 1-33 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 09/936,672.

Applicant's arguments filed December 30, 2003, have been fully considered but they are not persuasive. At page 9 of the response, applicant states that they plan to file a terminal disclaimer in the future. However, this is not sufficient to remove the rejections, and thus they are maintained for the reasons of record.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 1761

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith Hendricks whose telephone number is (571) 272-1401. The examiner can normally be reached on M-F (8:30am-6pm); First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**KEITH HENDRICKS**  
**PRIMARY EXAMINER**